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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,857	03/28/2001	Jean Prevost	1912-0243P	1638

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EXAMINER
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BAHTA, ABRAHAM

ART UNIT	PAPER NUMBER
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1775

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DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/818,857

Applicant(s)

PREVOST ET AL.

Examiner

Abraham Bahta

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1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-8 are pending in this application. Claims 9-18 are canceled.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On page 5 of the specification the non-marking materials are described as non-marking rubber, rubber EPDM and plastics. The disclosure has no support for the term "rubberized" as recited in the above claims.

Claim 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-4, it is not clear what is meant by the term "rubberized". What is rubberized or what is being rubberized.?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Prevost

(USP 5,958,527).

Prevost teaches a synthetic grass playing surface comprising a backing, a large number of upstanding synthetic ribbons from the backing, and an infill layer of particulate material placed among the synthetic ribbons. The reference teaches the infill material may be resilient granules such as rubber, vermiculite, cork, foam plastic, black, cryogenically ground rubber or colored EPDM rubber. See col. 5, line 17- col. 6, line 39 and col. 7, lines 8-13. The granule materials of Prevost are known to have a characteristic of being non-marking when a ball comes in contact with the granules. The infill layer is made of a base course, a middle course and a top course. The base course is substantially of hard sand granules disposed immediately upon the top surface of the backing. The middle course is of intermixed hard sand granules and resilient rubber granules. The top course is substantially of resilient rubber granules. See col. 5, lines 35-48.

As to the limitation such that the infill layer includes a non-marking particulate rubberized material, EPDM rubber as disclosed in Prevost is known to be a non-marking material.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prevost '527.

As discussed above, Prevost teaches the present claimed invention except does not require the infill material to be a recycled material. Further, the reference fails to teach the specific length of the ribbon which projects above the infill layer as recited in claims 7-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to select a recycled material for economic reasons, e.g., to lower or reduce the cost of the ingredients or infill materials needed for the synthetic grass playing surface. Further, the reference at col. 4, lines 45-52 teaches that depending on the sport or other expected use of the surface, the upper portion of the synthetic ribbon may extend upwardly from the top surface of the top course from 0.25 to 1.00 inches to give the appearance of grass blades and control the rolling of balls during play. The reference also teaches that by modifying the thickness and density of the grass ribbon blades extending through the top surface, the rolling characteristic of a ball in play can be modified. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the length of the ribbons depending on the ultimate use of the playing surface as suggested by Prevost.

#### **Response to Applicant's Argument**

The applicant contends that the prior art of record fails to teach or suggest each and every limitation of the combination of the elements of the claimed invention of claim 1, including the

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limitation(s) of “said infill layer including a non-marking particulate material which is distributed so as to prevent a ball from being marked when the same hits the synthetic grass playing surface”. The applicant further argues that the resilient material described in Prevost ‘527 does not have the inherent characteristic of being non-marking as Prevost does not recognize the ball marking problem associated with an infill layer having a top layer of resilient granules, such as rubber, vermiculite, cork, foam plastic and black or colored EPDM rubber. The Examiner disagrees. The applicant on page 5 of the specification states the non-marking rubber particles may be EPDM rubber. The reference teaches the granules may be synthetic plastic granules, crushed slag or any other hard granular material such as vermiculite, cork, foam plastic, black or colored EPDM rubber. The Examiner contends that since the applicant admits that EPDM rubber is known to be a non-marking material and Prevost ‘527 uses the same known non-marking material as infill material, the limitation such that “the infill material includes an non-marking particulate rubberized material” as recited in the claims is met by the disclosure.

With respect to claim 3, the applicant argues the Prevost reference does not suggest a recycled rubber material that may be used as infill material. The Examiner agrees; however, it is within the judgment of a skilled artisan to select a recycled infill particulate material for economic reasons. Absent a showing of unexpected results the claim is not seen to provide patentable distinction over the reference.

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Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah, Jones, can be reached on (703) 308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



A. Bahta

06/10/03



DEBORAH JONES  
SUPERVISORY PATENT EXAMINER